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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/040,798	03/18/1998	VIKTOR KELLER	P5550	2256

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EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/02/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/040,798

Applicant(s)

KELLER ET AL.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the language “conventional” is indefinite as it is unclear what structure would necessarily comprise a “conventional” golf ball. The applicant’s remarks appear to try to equate a “conventional” golf ball with a golf ball that complies with USGA requirements, however, this language was never presented in the originally filed specification. In fact, the originally filed specification merely mentions that conventional golf ball covers are known to be made from ionomer, balata and slow-reacting, thermoset polyurethane. The specification fails to note at any time that a conventional golf ball as used in the application is intended to require a golf ball that complies with USGA standards.

Claim Rejections - 35 USC § 102

3. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Newcomb. Newcomb discloses a golf ball formed from reaction injection molding (column 1, lines

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36-40). The ball structure includes a homogeneous translucent plastic and a light stick inserted therein to make the golf ball multiple pieces. The light stick comprises the core for the golf ball and the translucent plastic comprises the cover formed from a reaction injection molded material. Note column 1, lines 55-57 teaching a polyurethane material for forming the golf ball.

Claim Rejections - 35 USC § 103

4. Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melvin et al. (562) or Cavallaro et al. (923), each in view of Newcomb (4,695,055). The latter reference renders it obvious to mold the polyurethane layers of the primary reference golf balls by a reaction injection molding process, since such is an obvious expedient for providing the desired resiliency in a golf ball, as illustrated by the secondary reference. Any other possible distinctions over said modified golf balls are deemed conventional molding techniques that would necessarily be used in such molding process.

Regarding instant claims 1-13, the particular details for the recited method have been determined to be obvious lacking a showing of their criticality by a new and unexpected result. See *In re Aller et al.* 105 USPQ 233. The appellant has noted that the references lack the particular flex modulus and reaction time of the instant claims, however, he has failed to produce any test results or arguments in affidavit form which would disprove that these numbers are merely workable ranges obtained by routine experimentation. Thus, it would have been obvious to one of ordinary skill in the art to form the golf ball of Melvin et al. or Cavallaro et al. utilizing the reaction injection

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molding method detailed by Newcomb and according to the instantly claimed numbers as the appellant has not shown that these particular numbers solve any stated purpose and it appears that the combination of Melvin et al. or Cavallaro et al. each in view of Newcomb would accomplish similar purposes.

Regarding claims 14-37, as set forth above, the combination of Melvin et al. or Cavallaro et al. each in view of Newcomb would provide a golf ball comprising a reaction injection molded material comprising polyurethane/polyurea.

Regarding claims 38-41, as set forth above, the combination of Melvin et al. or Cavallaro et al. each in view of Newcomb would provide a golf ball comprising a reaction injection molded material comprising polyurethane/polyurea. Further, the step defining recycling at least 20% of the polyurethane/polyurea has been determined to be obvious lacking a showing of the criticality for the recited amount.

Regarding claims 42-44, as set forth above, the combination of Melvin et al. or Cavallaro et al. each in view of Newcomb would provide a golf ball comprising a reaction injection molded material comprising polyurethane/polyurea. Also, as the appellant has failed to provide any test results or arguments in affidavit form which would disprove that these numbers are merely workable ranges obtained by routine experimentation, it would have been obvious to one of ordinary skill in the art to form the golf ball of Melvin et al. or Cavallaro et al. utilizing the reaction injection molding method detailed by Newcomb and according to the instantly claimed numbers.

Response to Arguments

5. Applicant's arguments filed December 3, 2002 have been fully considered, however, they are not deemed to be persuasive. Regarding the rejection under 35 USC 102(b), although the structure of Newcomb may be unlike that of the instant invention, the claims fail to define any of these differences. Indeed, Newcomb defines a multi-piece golf ball including a core (8, 10) and a cover formed from a reaction injection molded material comprising polyurethane.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding applicant's argument that the ball of Newcomb is a one-piece golf ball devoid of any separate core and inner cover layers, such argument is not well taken. The golf ball of Newcomb clearly provides a plurality of pieces which go to make up the golf ball. Further, the light stick (8, 10) is clearly a separate core from the outer plastic cover of the ball. Moreover, instant claim 14 fails to define inner cover layers as applicant argues, but instead only recites a core and separate cover which are clearly provided by the reference to Newcomb.

Regarding applicant's contention that Newcomb is not a conventional golf ball, attention is directed to the rejection under 35 USC 112, second paragraph where the language "conventional" in claim 1 has been found to be indefinite. Applicant appears to introduce this language in order to distinguish the instant invention from the specific

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teachings of Newcomb (stating that his ball is distinguishable from a conventional golf ball), however, it is unclear what applicant intends from this recitation. Applicant's remarks appear to try to equate a "conventional" golf ball with a golf ball which complies with USGA requirements, however, this is not supported by the originally filed specification. Indeed, the originally filed specification fails to mention at any time that the instant golf ball necessarily complies with USGA requirements or that a conventional ball is assumed to comply with these requirements.

Further, the applicant should note that the rejection for instant claim 1 is over the combination of Melvin et al. or Cavallaro et al. each in view of Newcomb where both Melvin et al. and Cavallaro et al. teach "conventional" golf balls. The secondary reference to Newcomb is relied upon solely for its suggestion that the reaction injection molding process for plastics is old and well known in the art of golf ball plastics and to utilize such with the plastics taught by either Melvin et al. or Cavallaro et al. would have been with the level of one having ordinary skill in the art.

Regarding applicant's statement that Newcomb lacks a teaching for the particulars associated with using reaction injection molding including the types of reactants, catalysts, or reactive components to be utilized, the cream, gel or reaction times, the types of molds, injectors, aftermixers, etc., the instant claims fail to recite any of these particular characteristics. Further, as Newcomb suggests that reaction injection molding is old and well known in the art of golf ball plastics, the particular details for the instantly recited method are determined to be obvious lacking a showing of their criticality by a new and unexpected result. The applicant has been invited numerous times to demonstrate the criticality for these recited details by providing test results in affidavit

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form, however, as he has failed to do so one of ordinary skill in the art can only assume that any differences between the instant invention and the proposed combination reside in workable ranges which would be obtained by routine experimentation.

Regarding the applicant's statement that because reaction injection molding was known at the time of the inventions of both Cavallaro and Melvin and neither Cavallaro nor Melvin mention the method, one of ordinary skill in the art must assume that a motivation does not exist, this logic is flawed. First, if either reference included a teaching for forming their golf ball using a reaction injection molding process a rejection under 35 USC 102(b) would have been proper. Second, it would be inane for one to assume that each and every well known method of manufacturing golf balls would be included in a disclosure of a patent. Here, we have a secondary teaching by Newcomb that reaction injection molding processes are well known in the art of golf ball plastics and a primary reference teaching a golf ball using a polyurethane.

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding the applicant's contention that the combination of Melvin et al. or Cavallaro et al. each in view of Newcomb lacks the teaching for the recited flex modulus and demold time, the applicant is again referred to the basis for the rejection under 35

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USC 103. The rejection clearly states that the particular details for the reaction injection molding process have been determined to be obvious lacking a showing of a new and unexpected result. As stated in the rejection in Paper No. 22, the applicant is invited to disprove that these numbers are merely workable ranges obtained by routine experimentation by providing test results or arguments in affidavit form.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

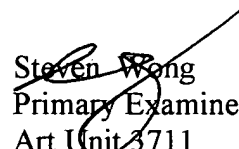
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Steven Wong
Primary Examiner
Art Unit 3711

SBW
April 24, 2003